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10/816,653	04/02/2004	Harpreet Singh	66329/00170	9663
23380 7590 04/29/2008 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414				
			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@tuckerellis.com
mary.eme@tuckerellis.com

Office Action Summary

Application No.

10/816,653

Applicant(s)

SINGH ET AL.

Examiner

THUY-VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 1-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/ISD)
Paper No(s)/Mail Date 04/02/04; 05/12/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed on 04/02/04 and 05/12/04 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Specification

2. The abstract of the disclosure is objected to because it is not written in the proper format. The abstract must be limited to a single paragraph of 150 words or less that provides a concise statement of the technical disclosure of the patent. Correction is required. See MPEP § 608.01(b).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d

1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 provisionally rejected on the ground of nonstatutory double patenting over claims 1 and 3 of copending Application No. 10818230. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

With respect to claim 1, the claims are reciting many of the same limitations although in slightly different language. The claimed allocation means is considered to be found in claim 3 of '230 due to the language reciting that the received data is stored as a selected storage medium in the data peripheral system. This appears to be different language that is defining the same overall limitation although in a slightly different scope. Claim 1 is considered to be obvious in view of claims 1 and 3 of

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copending Application 10818230 due to the use of slightly different language to define an invention of similar but not identical scope, which is obvious. A terminal disclaimer is also required to maintain common ownership of claims of overlapping scope so that two different entities cannot own the right to exclude for the claims of overlapping scope.

Instant Application	Co-pending application
<p>1. A system for providing fee-based access to shared data peripheral devices comprising:</p> <p>a data peripheral system comprising at least one data input/output device;</p> <p>data communication means adapted for communicating data from the at least one data input/output device into the selected storage area of secure data storage medium;</p> <p>accounting means adapted for securing charge information from an associated user, which charge information allows for securing of payment for use of the data peripheral system;</p> <p>verification means adapted for securing charge verification information corresponding to charge information received from the associated user; and</p> <p>enabling means adapted for enabling operation of the data peripheral system in accordance with an output of the verification</p>	<p>1. A system for providing fee-based access to shared data peripheral devices comprising:</p> <p>a data peripheral system comprising at least one data input/output device;</p> <p>data communication means adapted for receiving a data storage medium so as to communicate data stored therein to the at least one data input/output device;</p> <p>accounting means adapted for securing charge information from an associated user, which charge information allows for securing of payment for use of a selected data processing operation of the data peripheral system undertaken in connection with data received from the data storage medium;</p> <p>verification means adapted for securing charge verification information corresponding to charge information received from the associated user; and</p> <p>enabling means adapted for enabling operation of the data peripheral system in accordance with an output of the</p>

means so as to provide fee-based access of the associated user to the peripheral system.	verification means so as to provide fee-based access of the associated user to the peripheral system.
Allocation means adapted to allocate a selected storage area in the secure data storage medium;	3. The system of claim 1 wherein the selected data processing operation undertaken in connection with the data received from the data storage medium is at least one of printing selected data received from the data storage medium, storing selected data received from the data storage medium in as selected storage medium located in the data peripheral system, and transmitting selecting selected data received from the data storage medium to at least one selected destination.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 17, the preamble reciting that the claim is directed to a "Computer readable medium" but the body of the claim recites more of a system and includes an input/output device. A computer readable medium does not include an input and output device as that would be a system. Therefore, it is not clear if the claim is directed to a system or just a computer readable medium.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4-8, 9-10, 12-16, 17-18, 20-22, 23-24, 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamada (US 7,254,606).

Regarding claim 1, Hamada discloses a system for providing fee-based access to shared data peripheral devices comprising:

a data peripheral system comprising at least one data input/output device [figure 1; col. 4, lines 25-40];

a secure data storage medium [...i.e. servers 111 and 112 stores encryption algorithm programs used to encrypt user data; figure 1; col. 5, lines 63-66; col. 6, lines 32-37; supplying a storage medium or recording medium; col. 17, lines 24-32];

allocation means adapted to allocate a selected storage area in the secure data storage medium [...i.e. sending the data with the data storage request to the selected data server, and store the data in the select data server; abstract; and figures 2 and 15];

data communication means adapted for communicating data from the at least one data input/output device into the selected storage area of secure data storage medium [...i.e. *network (10); sending the data associated with the data storage request to the selected data server via the communication line*; figures 1, 11 and 12; col. 1, lines 60-62; col. 3, lines 20-26; col. 4, lines 13-20];

accounting means adapted for securing charge information from an associated user, which charge information allows for securing of payment for use of the data peripheral system [...i.e. *charge process for a user to pay a fee for the use of data system*; figures 24-25; col. 15, lines 33-60] ;

verification means adapted for securing charge verification information corresponding to charge information received from the associated user [...i.e. *sending a message indicating that the service subscription value has paid*; col. 16, lines 32-42; figure 24, step (1823)]; and

enabling means adapted for enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system [...i.e. *enabling the process of sending the requested storage data to data server from client terminal; and the process of receiving the data from the data server*; col. 3, lines 1-6; col. 8, lines 32-67; col. 9, lines 1-2 and figures 2-3].

Regarding claim 2, Hamada discloses means adapted for storing an access control list which access control list dictates an identity of users authorized to access data stored in the selected storage area of the secure data storage medium [...i.e.

server 111 stores a member profile, a data user profile and storage data list; col. 5, lines 63—66; col. 6, lines 1-9 and figure 5];

Regarding claim 4, Hamada discloses wherein the data peripheral system includes at least one of a printer, facsimile, scanning device, character recognition system, and storage device [...figure 1].

Regarding claim 5, Hamada discloses means adapted for selecting parameters for a selected data processing operation undertaken in connection with the data stored in the secure data storage medium [...i.e. *user select a data server in which he or she want to store data*; col. 6, lines 9-13; col. 12, lines 62-66 and figures 2 and 14];

Regarding claim 6, Hamada discloses wherein the charge information includes information associated with at least one of a pre-paid debit card, coupon, and credit card [...*debit card or credit card*; col. 17, lines 3-9].

Regarding claim 7, Hamada discloses tracking means adapted for tracking the user's usage of the data peripheral system and cost generating means adapted for receiving an output from the tracking means and generating a cost for the user's usage of the data peripheral system [...i.e. *control server 111 and IC card 124 manage user's information such as charge information, various kinds of information with the storage data servers*; col. 16, lines 45-52; and figures 1, 22 and 24].

Regarding claim 8, Hamada discloses billing means adapted for receiving an output from the cost generating means and applying the output to the user's charge information [...i.e. *calculating the value of data usage, and then send to the user; and*

then send the message to the server of the use's bank to designates the amount to be paid; col. 15, lines 5560; col. 16, lines 4-8; lines 22-24; lines 32-35; figure 24].

Regarding claim 9, Hamada discloses a method for providing fee-based access to shared data peripheral devices comprising the steps of:

allocating a selected storage area in a secure data storage medium [...i.e. sending the data with the data storage request to the selected data server, and store the data in the select data server; abstract; and figures 2 and 15];

communicating data from at least one data input/output device in a data peripheral system into the selected storage area of secure data storage medium [...i.e. network (10); sending the data associated with the data storage request to the selected data server via the communication line;; figures 1, 11 and 12; col. 1, lines 60-62; col. 3, lines 20-26; col. 4, lines 13-20];

securing charge information from an associated user, which charge information allows for securing of payment for use the data peripheral system [...i.e. charge process for a user to pay a fee for the use of data system; figures 24-25; col. 15, lines 33-60];

securing charge verification information corresponding to charge information received from the associated user [...i.e. sending a message indicating that the service subscription value has paid; col. 16, lines 32-42; figure 24, step (1823)]; and

enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated

user to the peripheral system [...i.e. *enabling the process of sending the requested storage data to data server from client terminal; and the process of receiving the data from the data server*; col. 3, lines 1-6; col. 8, lines 32-67; col. 9, lines 1-2 and figures 2-3].

Regarding claim 10, Hamada discloses further comprising the step of storing an access control list, which access control list dictates an identity of users authorized to access data stored in the selected storage area of the secure data storage medium [...i.e. *server 111 stores a member profile, a data user profile and storage data list*; col. 5, lines 63—66; col. 6, lines 1-9 and figure 5];

Regarding claim 12, Hamada discloses the data peripheral system includes at least one of a printer, facsimile, scanning device, character recognition system, and storage device [...figure 1].

Regarding claim 13, Hamada discloses the step of selecting parameters for a selected data processing operation undertaken in connection with the data stored in the secure data storage medium [...i.e. *user select a data server in which he or she want to store data*; col. 6, lines 9-13; col. 12, lines 62-66 and figure 14];

Regarding claim 14, Hamada discloses the charge information includes information associated with at least one of a pre-paid debit card, coupon, and credit card [...*debit card or credit card*; col. 17, lines 3-9].

Regarding claim 15, Hamada discloses the step of tracking the user's usage of the data peripheral system and generating a cost for the user's usage of the data peripheral system [...i.e. *control server 111 and IC card 124 manage user's*

information such as charge information, various kinds of information with the storage data servers; col. 16, lines 45-52; and figures 1, 22 and 24].

Regarding claim 16, Hamada discloses the step of applying the generated cost to the user's charge information [*...i.e. calculating the value of data usage, and then send to the user; and then send the message to the server of the use's bank to designates the amount to be paid; col. 15, lines 5560; col. 16, lines 4-8; lines 22-24; lines 32-35; figure 24].*

Regarding claim 17, Hamada discloses a computer-readable medium for providing
fee-based access to shared data peripheral devices comprising:

a data peripheral system comprising at least one data input/output device [figure 1; col. 4, lines 25-40];

a secure data storage medium [*...i.e. servers 111 and 112 stores encryption algorithm programs used to encrypt user data; figure 1; col. 5, lines 63-66; col. 6, lines 32-37; supplying a storage medium or recording medium; col. 17, lines 24-32];*

allocation means adapted to allocate a selected storage area in the secure data storage medium [*...i.e. sending the data with the data storage request to the selected data server, and store the data in the select data server; abstract; and figures 2 and 15];*

data communication means adapted for communicating data from the at least one data input/output device into the selected storage area of secure data storage [*...i.e. network (10); sending the data associated with the data storage request*

to the selected data server via the communication line;; figures 1, 11 and 12; col. 1, lines 60-62; col. 3, lines 20-26; col. 4, lines 13-20];

accounting means adapted for securing charge information from an associated user, which charge information allows for securing of payment for use of the data peripheral system [...i.e. *charge process for a user to pay a fee for the use of data system*; figures 24-25; col. 15, lines 33-60];

verification means adapted for securing charge verification information corresponding to charge information received from the associated user [...i.e. *sending a message indicating that the service subscription value has paid*; col. 16, lines 32-42; figure 24, step (1823)]; and

enabling means adapted for enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system [...i.e. *enabling the process of sending the requested storage data to data server from client terminal; and the process of receiving the data from the data server*; col. 3, lines 1-6; col. 8, lines 32-67; col. 9, lines 1-2 and figures 2-3].

Regarding claim 18, Hamada discloses means adapted for storing an access control list, which access control list dictates an identity of users authorized to access data stored in the selected storage area of the secure data storage medium [...i.e. *server 111 stores a member profile, a data user profile and storage data list*; col. 5, lines 63—66; col. 6, lines 1-9 and figure 5];

Regarding claim 20, Hamada discloses the charge information includes information associated with at least one of a pre-paid debit card, coupon, and credit card [...*debit card or credit card*; col. 17, lines 3-9].

Regarding claim 21, Hamada discloses comprising tracking means adapted for tracking the user's usage of the data peripheral system and cost generating means adapted for receiving an output from the tracking means and generating a cost for the user's usage of the data peripheral system [...*i.e. control server 111 and IC card 124 manage user's information such as charge information, various kinds of information with the storage data servers*; col. 16, lines 45-52; and figures 1, 22 and 24].

Regarding claim 22, Hamada discloses billing means adapted for receiving an output from the cost generating means and applying the output to the user's charge information [...*i.e. calculating the value of data usage, and then send to the user; and then send the message to the server of the use's bank to designates the amount to be paid*; col. 15, lines 5560; col. 16, lines 4-8; lines 22-24; lines 32-35; figure 24].

Regarding claim 23, Hamada discloses a computer-implemented method for providing fee-based access to shared data peripheral devices comprising the steps of:
allocating a selected storage area in a secure data storage medium [...*i.e. sending the data with the data storage request to the selected data server, and store the data in the select data server*; abstract; and figures 2 and 15];

communicating data from at least one data input/output device in a data peripheral system into the selected storage area of secure data storage medium [...*i.e.*

network (10); sending the data associated with the data storage request to the selected data server via the communication line;; figures 1, 11 and 12; col. 1, lines 60-62; col. 3, lines 20-26; col. 4, lines 13-20];

securing charge information from an associated user, which charge information allows for securing of payment for use the data peripheral system [...i.e. *charge process for a user to pay a fee for the use of data system; figures 24-25; col. 15, lines 33-60];*

securing charge verification information corresponding to charge information received from the associated user user [...i.e. *sending a message indicating that the service subscription value has paid; col. 16, lines 32-42; figure 24, step (1823)]; and*

enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system [...i.e. *enabling the process of sending the requested storage data to data server from client terminal; and the process of receiving the data from the data server; col. 3, lines 1-6; col. 8, lines 32-67; col. 9, lines 1-2 and figures 2-3].*

Regarding claim 24, Hamada discloses the step of storing an access control list, which access control list dictates an identity of users authorized to access data stored in the selected storage area of the secure data storage medium [...i.e. *server 111 stores a member profile, a data user profile and storage data list; col. 5, lines 63—66; col. 6, lines 1-9 and figure 5];*

Regarding claim 26, Hamada discloses the charge information includes information associated with at least one of a pre-paid debit card, coupon, and credit card [...*debit card or credit card*; col. 17, lines 3-9].

Regarding claim 27, Hamada discloses the step of tracking the user's usage of the data peripheral system and generating a cost for the user's usage of the data peripheral system [...*i.e. control server 111 and IC card 124 manage user's information such as charge information, various kinds of information with the storage data servers*; col. 16, lines 45-52; and figures 1, 22 and 24].

Regarding claim 28, Hamada discloses the step of applying the generated cost to the user's charge information [...*i.e. calculating the value of data usage, and then send to the user; and then send the message to the server of the use's bank to designates the amount to be paid*; col. 15, lines 5560; col. 16, lines 4-8; lines 22-24; lines 32-35; figure 24].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3,11, 19, 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada in view of Aoyagi (US 2003/0071900).

Regarding claims 3, 11, 19, 25, Hamada discloses the claim invention as stated above. However, Hamada doesn't explicitly disclose means adapted for selectively de-allocating the selected storage area in the secure data storage medium after expiration of a pre-selected duration.

Aoyagi discloses means adapted for selectively de-allocating the selected storage area in the secure data storage medium after expiration of a pre selected duration [...i.e. the image data to be deleted/de-allocated based on the order of the image data retention dates; par. 0055; abstract and figure 7].

Therefore, It would have been obvious in one of ordinary skill in the art at the time of the invention to incorporate the allocating the image data in a storage medium of Hamada to include the method of de-allocating the image data as taught by Aoyagi in order to reduced the storage capacity medium as well as reducing the customer usage's charge.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
13. The US Patent Application Publication King et al. discloses a system and method for transferring digital image data for archiving and for ordering photographic prints through the network, and the US Patent to Shiimori et al. discloses system and method for offering information service, method of assisting information release service, and information sharing server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy-Vi Nguyen/

Examiner, Art Unit 3689

/Dennis Ruhl/

Primary Examiner, Art Unit 3689